



Dkt. 58122-Z CCD

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Fumiaki ARAI et al.

Serial No.: 10/060,458

Group Art Unit 1762

Filed : January 30, 2002

Examiner J.K. Michener

For : THERMOSENSITIVE STENCIL PAPER  
AND METHOD OF PRODUCING THE SAME

**SECOND RESPONSE TO FINAL OFFICE ACTION**

1185 Avenue of the Americas  
New York, N.Y. 10036  
October 5, 2004

Hon. Commissioner of Patents,  
P. O. Box 1450,  
Alexandria, VA 22313-1450

S I R:

Attention is respectfully directed to the attached Facsimile copy of a Declaration under 37 C.F.R. § 1.132 by Masanori Rimoto, one of the joint applicants in the above-identified application.

The Declaration under §1.132 describes experiments performed under the supervision of the Declarant to determine whether a water-in-oil emulsion formed of silicone oil, THF, water and a surfactant would form a porous resin layer after drying. As stated on p. 3 of the Declaration, as a result of these experiments it was concluded that a water-in-oil emulsion formed of silicone oil, THF, water and a surfactant "does not form a porous resin layer of the present invention."


Claim 11 of the present application, on which all other claims now in the application are dependent, recites "coating on said thermoplastic resin film a porous resin layer formation coating liquid." In the Advisory Action dated July 30, 2004, the Examiner maintained the final rejection of claims 11, 14, 16, 17, 19 and 20 under 35 U.S.C. §102(e) as anticipated by Ohta et al.

'560 on the ground that "Ohta's silicone oil in water with the use of an emulsifier will create Applicant's water-in-oil emulsion."

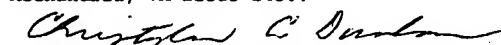
Based on the test results set forth in the attached Declaration under §1.132, the Declarant states (p. 1, numbered paragraph 5) "that the w/o emulsion formed of the compounds selected within the disclosure of Ohta et al. does not form a porous layer after drying." It follows that Ohta et al. cannot properly be considered to anticipate applicants' claim 11 (or any of the other pending claims, all dependent on claim 11), i.e., because claim 11 requires the step of "coating on said thermoplastic resin film a porous resin layer formation coating liquid," whereas the material assertedly taught by Ohta et al. '560 and relied on by the Examiner in the rejection does not form a porous layer.

In view of the Statement of Common Ownership set forth in applicants' First Reply to Final Rejection filed July 6, 2004, Ohta et al. '560 is not applicable as a reference against the present claims under 35 U.S.C. §103(a). Since Ohta et al. does not anticipate any of the claims under §102(e), for the reasons discussed above and set forth in the attached Declaration under §1.132, it is respectfully requested that claim 11 and all the claims dependent thereon (including withdrawn dependent species claims 13, 15 and 21) be allowed.

Respectfully,

  
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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Christopher C. Dunham, Reg. No. 22,031

Date: OCT. 5, 2004